

Application Serial No. 09/091,510
Response dated July 7, 2005
Reply to Office action of April 8, 2005

REMARKS

Claims 1, 3, 4, 5, 7, 8, 10 through 33, 35 through 45, 59, 60, 65 through 68, and 70 through 85 remain pending in this application. Reconsideration of this application is respectfully requested in view of the following remarks.

Response to Arguments:

The Applicants acknowledge with appreciation the consideration of the arguments filed September 9, 2004.

Claim Rejections - 35 U.S.C. § 103:

The Office action rejects claims 1, 3, 4, 5, 7, 8, 10 through 22, 28 through 33, 35 through 45, 59, 60, 65 through 68, 70 through 76, and 80 through 85 under 35 U.S.C. § 103 as unpatentable over Adams *et al.*, US 5,541,662 in view of Handelman *et al.*, US 5,414,773 and Volk *et al.*, US 5,687,331. The rejection is traversed. Withdrawal of the rejection is respectfully requested.

Claim 1 recites,

“the processor being responsive to received viewer command signals to vary the interactive image and to cause the modem to transmit data to and receive on-line data from a remote site for on-line interaction via the interactive image between the viewer and the remote site.”

Neither Adams, Handelman, nor Volk teach, disclose, or suggest a processor being *responsive* to received viewer command signals to vary an interactive image and to *cause* a modem to transmit data to and receive on-line data from a remote site for on-line interaction via the interactive image between a viewer and the remote site, as recited in claim 1. Modem 58 in Adams does not transmit and receive on-line data from a remote site, as acknowledged

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graciously in the Office action. The Office action seeks to compensate for the deficiencies of Adams by combining it with Handelman. Receive-transmit fax modem unit 150 of Handelman, however, is used for facsimile data, E-mail data, voice-mail data, mail data, and communication management data from telephone network 124, as described at column 8, lines 45-48, not transmitting data to and receiving on-line data from a remote site for on-line interaction via the interactive image between a viewer and the remote site, as recited in claim 1. Neither facsimile data, E-mail data, voice-mail data, mail data, nor communication management data from telephone network 124 could in any sense be considered *on-line* data, let alone on-line data from a remote site for on-line interaction via the interactive image between a viewer and the remote site. Volk has no modem at all, and thus cannot make up for the deficiencies of either Adams or Handelman with respect to claim 1. Thus, even if Adams, Handelman and Volk were combined as proposed in the Office action, the claimed invention would not result.

The Office action, in particular, relies on the data modem 58 of Adams to meet the modem limitation of claim 1. The sole function of the data modem 58 of Adams, however, is to demodulate digital data received over the broadcast stream; see col. 5, lines 54 to 62, and Figs. 1 and 2 observing in particular communication line 30. Hence, the data modem 58 is more analogous to the decoder than to the modem in claim 1. The Office action appears to recognize this, since it identifies the decoder of claim 1 as the data selector 78 (top of page 3 of the OA), yet the data selector 78 is *part* of the data modem 58 (see col. 6, line 8).

There is no disclosure in Adams that the data modem 58 is able to establish a telecommunications link and to transmit data to and receive data from a remote site via that link, as discussed above. Instead, the data modem 58 only receives data from a broadcast stream. Although Figures 2 and 3 appear to indicate a bidirectional link to the data modem 30, this is not mentioned anywhere in the description and does not indicate that *user* data is transmitted; instead, it may simply indicate signaling for internal control purposes. Compare for example the bidirectional lines between the queues 70, 72, 74 and the system bus 51, by which the data

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modem driver 106 manages the queues (see col. 8, lines 32 to 34). Any data sent by the data modem 58 could not proceed beyond the receivers 14, 16, 18, as these are all broadcast receivers and do not transmit data.

The Office action cites the 'known advantage of conserving bandwidth in a TV system, and utilizing the low-bandwidth channels for transmission of data' (page 4, lines 3 to 5) as a motivation to combine Adams with Handelman; but Adams does not *transmit* data from the data modem 58, so this potential advantage does not arise. Moreover, the Office action says the skilled person would be motivated to use the modem 58 of Adams for sending fax or email, but this is not possible since the modem does not transmit any data, whether fax, email or otherwise. And even if it did, neither faxes or emails amount to *on-line* data from a remote site for on-line interaction via the interactive image between a viewer and the remote site, as discussed above.

Handelman discloses a CATV system with an integrated fax modem 119, 150 for providing additional applications such as fax and email (col. 1, lines 58 to 60). The aim of Handelman is to provide additional applications to CATV systems that already have two-way modems (col. 1, lines 41 to 47). Persons of ordinary skill in the art would therefore not have sought to combine Handelman with Adams, since the latter does not have a two-way modem and thus, apparently, has no need for one.

Furthermore, Handelman does not disclose the use of interactive images, and in particular does not disclose any connection between the integrated fax modem 119, 150 and an interactive image. The Office action cites Volk as disclosing interactive images/icons, but the cited passages do not disclose at least the feature of 'online interaction via the interactive image between the viewer and the remote control' as claimed. Instead, the software for the interactive icons is pre-loaded as program modules 202 and stored in the memory of the terminal prior to interactive use of the icons.

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Hence, even the combination of Adams, Handelman and Volk still fails to disclose the claimed subject matter. Moreover, the Office action is attempting to mosaic three distinct documents, with no valid motivation to combine. This indicates that the claims are not obvious over the cited documents.

Furthermore, disparate references, no matter how notoriously well known they may or may not have been at the time of the invention, does not rise to the level of proof need for a rejection under 35 U.S.C. § 103(a). 35 U.S.C. § 103(a) and the M.P.E.P. §706.02(j)(D), rather, require the claimed *combination* of elements to have been obvious to persons of ordinary skill in the art at the time the invention was made, not just any particular individual element.

Merely pointing to descriptions of one or another of the individual elements, such as, for example, sending faxes or emails, does not render the claimed *combination* of elements obvious.

"It is insufficient that the prior art [discloses] the components . . . either separately or used in other combinations; there must be some teaching, suggestion, or incentive to make the combination made by the inventor." *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931, 15 USPQ2d 1321 (Fed. Cir. 1990), *cert. denied*, 498 U.S. 920 (1990).

"When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references." *In re Rouffet*, 47 USPQ2d 1453, 1456 (Fed. Cir. 1998); see also M.P.E.P. § 2143.01. Virtually all inventions are combinations of old elements. *See In re Rouffet*, 47 USPQ2d at 1457. If identification of each claimed element in the prior art were sufficient to negate patentability, the Office action could use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. *See Id.* To prevent the use of hindsight based on the teachings of the patent application, the Office action must show a motivation to combine the references in the manner suggested. *See Id.* at 1457-1458.

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Claim 1 is thus submitted to be allowable. Withdrawal of the rejection of claim 1, and the claims dependent thereon, is earnestly solicited.

Claim 28 recites,

“responding to received said command signals by varying the interactive image and causing the modem to establish a telecommunications link to a remote site for on-line interaction via the interactive image between the viewer and the remote site.”

Neither Adams, Handelman, nor Volk teach, disclose, or suggest responding to received command signals by varying an interactive image and causing a modem to establish a telecommunications link to a remote site for on-line interaction via the interactive image between a viewer and the remote site, as discussed above with respect to claim 1. Claim 28, as well as the claims dependent thereon, is thus also submitted to be allowable.

Claim 70 recites,

“the processor being responsive to received viewer command signals to cause the modem to transmit data to and receive on-line data from a remote site for on-line interaction via the interactive image between the viewer and the remote site and to output for display a further interactive image derived from said image data, said information data and said received on-line data.”

Neither Adams, Handelman, nor Volk teach, disclose, or suggest a processor being responsive to received viewer command signals to cause a modem to transmit data to and receive on-line data from a remote site for on-line interaction via an interactive image between a viewer and the remote site, as discussed above with respect to claim 1. Claim 70, as well as the claims dependent thereon, is thus also submitted to be allowable.

Claim 80 recites,

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“responding to said command signals to vary the interactive image and to cause the modem to transmit data to and receive on-line data from a remote site for on-line interaction via the interactive image between the viewer and the remote site and to output for display a further interactive image derived from said image data, said information data and said received on-line data.”

Neither Adams, Handelman, nor Volk teach, disclose, or suggest responding to command signals to vary an interactive image and to cause a modem to transmit data to and receive on-line data from a remote site for on-line interaction via the interactive image between a viewer and the remote site, as discussed above with respect to claim 1. Claim 80, as well as the claims dependent thereon, is thus also submitted to be allowable.

Accordingly, claims 1, 3, 4, 5, 7, 8, 10 through 22, 28 through 33, 35 through 45, 59, 60, 65 through 68, 70 through 76, and 80 through 85 are believed to be patentable over Adams, Handelman, and Volk. Withdrawal of the rejection of claims 1, 3, 4, 5, 7, 8, 10 through 22, 28 through 33, 35 through 45, 59, 60, 65 through 68, 70 through 76, and 80 through 85 is earnestly solicited.

Claims 23 through 27, 77 and 78 are rejected under 35 U.S.C. § 103(a) as unpatentable over Adams, Handelman, and Volk, and further in view of Schutte, US 5,319,454. The rejection is traversed. Withdrawal of the rejection is respectfully requested.

Claims 23 through 27 and 78 depend from claim 1, while claim 77 depends from claim 70. Neither Adams, Handelman, nor Volk describe a processor being *responsive* to received viewer command signals to vary an interactive image and to *cause* a modem to transmit data to and receive on-line data from a remote site for on-line interaction via the interactive image between a viewer and the remote site, as discussed above with respect to claim 1.

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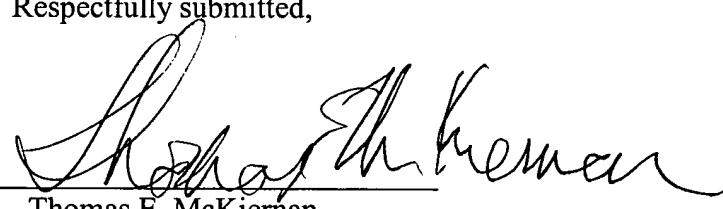
It is respectfully submitted that Schutte does not, either. Since neither Adams, Handelman, Volk nor Schutte disclose a processor being *responsive* to received viewer command signals to vary an interactive image and to *cause* a modem to transmit data to and receive on-line data from a remote site for on-line interaction via the interactive image between a viewer and the remote site separately, their combination cannot, either. Claims 23 through 27, 77 and 78 are thus submitted to be allowable. Withdrawal of the rejection of claims 23 through 27, 77 and 78 is earnestly solicited.

Conclusion:

In view of the above amendments and remarks, it is believed that the claims satisfy the provisions of the patent statutes and are patentable over the prior art. Reconsideration and early notice of allowance are requested.

Respectfully submitted,

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